

REMARKS

The Office Action dated June 14, 2007 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 26 through 40 are pending. Claims 26 and 32 have been amended claim 41 remains withdrawn from consideration, and claims 42 through 49 are canceled without prejudice or disclaimer.

Applicants thank the Examiner for indicating that claims 33 through 40 are allowed.

Applicants thank the Examiner for the Interview of July 16, 2007 during which the Examiner clarified that the Office Action of June 14 is a final Office Action and that the Restriction Requirement set forth therein was simply to clarify the grouping of claims set forth earlier in prosecution.

Applicants also thank the Examiner for the Interview of August 14, 2007, the details of which are set forth below.

Restriction:

To clarify the record, the Examiner asserts that claim 41 remains distinct from claims 26-40, albeit for reasons different than those originally presented in the Office Action of June 19, 2006. Therefore, the Examiner has reaffirmed that restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 26 through 40, drawn to the method of illuminating a rotary blade, classified in class 427, subclass 407.1; and
- II. Claim 41, drawn to a photoluminescent paint system, classified in class 428, subclass 411.1+

In accordance with Applicant's original election of July 18, 2006, Applicants reaffirm the election of claims of Group I, *i.e.*, claims 26 through 40, for prosecution in the instant application. Applicants reserve the right to file divisional applications for the subject matter covered by the remaining groups.

Claim Rejections—35 USC 112:

In the outstanding Office Action, the Examiner rejected claims 26 through 32 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Namely, the Examiner asserts that Applicants' specification discloses that luminescence is visible through the 5.5 hour test period and "readily visible" thereafter, but that Applicants do not have support for extinction times for the "greater than 5.5 hours" portion of the range. Further, the Examiner rejected claims 26 through 32 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Namely, the Examiner asserts, as noted above, open-ended ranges must be carefully scrutinized and that Applicants do not have full support for the upper range of the claimed "greater than 5.5 hours" range, and specifically, that the phrase "an extinction time of 5.5 hours" is such that one of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

The Manual of Patent Examination Procedure (MPEP) explicitly acknowledges that the recitation of a range in a claim does not render the claim indefinite and that open-ended ranges are permissibly under 35 U.S.C. §112.¹ For example, the MPEP specifically acknowledges that the Board of Patent Appeals has found that open ended claims may satisfy the requirements of 35 U.S.C. §112, second paragraph.² Moreover, claim limitations with an open-ended upper ranges are commonly recognized as acceptable claim language satisfying the requirements of 35 U.S.C. §112, second paragraph.³

As set forth in the Interview of August 14, 2007, Applicants proposed to amend claims 26 and 32 as officially set forth above to read "...wherein the photoluminescent paint when activated

¹ See, MPEP §2173.05(c).

² See, MPEP §2173.05(c) citing, *Ex parte Khusid*, 174 USPQ 59 (Bd. App. 1971).

³ See e.g., *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 546, 31 USPQ2d 1666, 1670 (Fed.Cir.1994) ("[T]he term 'at least two' sets forth the minimum number of a particular element required."); *Hybritech, Inc. v. Abbott Labs.*, 849 F.2d 1446, 1455, 7 USPQ2d 1191, 1199 (Fed.Cir.1988) (The Federal Circuit found a reasonable likelihood of success of proving that the accused products infringe a patent with a recited claim limitation for affinity of "at least about 10 liters/mole"); *Ralston Purina Co. v. Far-Mar-Co, Inc.* 772 F.2d 1570, 1576 (C.A.Fed.,1985) (In finding the limitations "at least about 25% by weight," and "at least 25% by weight" allowable, the Federal Circuit stated "The open-ended claims, however, would be limited by what a person skilled in the art would understand to be workable.")

is luminous for at least about 5.5 hours.” Applicants assert that the “at least about 5.5 hours” portion of the range is supported by the specification and that the metes and bounds of the upper range of the claim can be interpreted by one of ordinary skill in the art. First, as noted by the Examiner, the specification sets forth, *inter alia*, in paragraph 31 and the corresponding tables that the luminescent paint was tested for just under 5.5 hours and was readily visible after the 5.5 hour test period. Further, as set forth in paragraph 32, the specification sets forth that luminance can be enhanced beyond the figures given in the Tables of the specification. Specifically, luminance can be enhanced if either the activation light intensity or the exposure time is maximized. Thus, by maximizing either the activation light intensity or the exposure time, the time and intensity of the luminance can be increased. With this disclosure, Applicants provide those skilled in the art with the instruction needed to determine how long the luminescent characteristics can last. Through simple experimentation, one skilled in the art can increase either or both of activation light intensity or exposure time to determine upper ranges of luminescence periods.

In the Interview, the Examiner agreed that the proposed amendment would be supported by the application and that the metes and bounds of the upper range of the claim can be interpreted by one of ordinary skill in the art. Accordingly, Applicants assert that with the above-amendments overcome the rejections under 35 USC 112, first and second paragraphs and that the application is now in condition for allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this Application and the prompt allowance of at least claims 26 through 40.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Kimberly O. Snead at 703-563-2043 to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 10-0233. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,

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